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#15

7200

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(89,348-A)

In the Application of:

Michael F. Jones

RECEIVED

Serial No.: 07/872,674

JUN 26 1994

OFFICE OF PETITIONS
AIC PATENTS

Filed: April 23, 1992

Before the Examiner:

B. Gregory

For: Encrypted Data Transmission System
Employing Means for Randomly
Altering the Encryption Keys

Group Art Unit:

2202

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231
BOX DAC

MAILED

JUN 29 1994

GROUP 2200

PETITION UNDER 37 CFR 1.137(b)
TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION

Sir:

Applicant requests that the present application, which was unintentionally abandoned, be revived as a pending application under 37 CFR 1.137(b). A declaration recounting the events leading to the abandonment and including a statement pursuant to 37 CFR 1.137(b) that the abandonment was unintentional accompanies the present petition. Additionally, applicant is submitting herewith a Request for Reconsideration which resubmits earlier filed amendments and explains why such amendments should have been entered. As demonstrated in the following statement of facts, the events leading to the abandonment of the present application were unintentional and revival of the application is accordingly appropriate.

070 FF 06/27/94 07872674

1 241 585.00 CK

A check in the amount of \$585.00 is enclosed for the required fee as set forth in 37 CFR 1.17(m). The Commissioner is further authorized to charge any additional fees or credit any overpayment to Deposit Account 01-0850.

STATEMENT OF THE FACTS

Claims 8-12 were pending in the application before abandonment. In a final Office Action mailed July 8, 1993, the Examiner rejected claims 8, 11 and 12 under 35 U.S.C. §§ 102 or 103. Dependent claims 9 and 10 were objected to, but were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Office Action set a shortened statutory period of three months for response.

On December 8, 1993, applicant mailed a response to the Office Action of July 8, 1993, entitled as an "Amendment After Final", along with petition and fee under 37 CFR 1.136(a) for a two month extension of time. In the response, applicant cancelled the rejected claims and submitted a new independent claim 13 which included the limitations of the objected dependent claim 9 and all of the limitations of the base claim 8, upon which claim 9 depended. In addition, dependent claim 10 was amended to depend upon claim 13 rather than cancelled claim 9.

In an advisory action mailed on January 28, 1994, twenty days after expiration of the six month statutory period, the Examiner stated that applicant's new claim 13 would not be entered because (1) there was no convincing showing under 37 CFR 1.116(b) why the proposed amendment was necessary and was not earlier presented, (2) the amendment raised

new issues that would require further consideration and/or search, and (3) the amendments were not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The Advisory Action set a period for response which continued to run five months from the date of final rejection, which occurred six months and twenty days previously on July 8, 1993.

On February 7, 1994 a Notice of Abandonment was mailed informing applicant that the application was abandoned in view of the failure to respond to the Office Action mailed on July 8, 1993.

ARGUMENT

Applicant requests that the Commissioner revive the present application, in order to redress an unintentional abandonment of the application. Applicant is submitting herewith a Request for Reconsideration which requests reconsideration and entry of the amendments contained in the response submitted December 8, 1993.

Revival is appropriate in light of the unintentional nature of the abandonment in the present application. As demonstrated in the above statement of facts, applicant fully complied with the Examiner's rejections and objections by cancelling rejected claims, and rewriting objected claims in independent form. Rewritten independent claim 13 included only the elements of rejected claim 8 and objected claim 9, and accordingly included no new matter. Applicant fully expected that the full compliance with the Examiner's statements regarding claims 9 and 10 would result in allowance of claims 13 and 10.

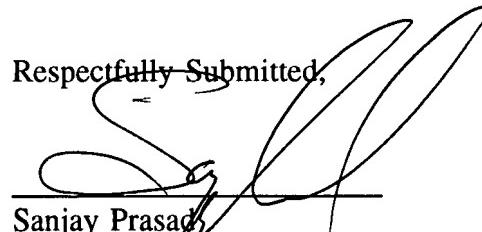
Instead, applicant was informed by the Advisory Action of January 28, 1994 that

proposed claim 13 "appears not to be patentable over prior art of record." Applicant is submitting herewith a Request for Reconsideration which addresses the propriety of the amendment. To submit the Request and to obtain allowance of the claims indicated to be allowable, applicant requests that the present application be revived due to the demonstrated unintentional nature of the abandonment.

6/10/94

Date

Respectfully Submitted,


Sanjay Prasad
Reg. No. 36,247

Allegretti & Witcoff, Ltd.
Ten South Wacker Drive
Chicago, Illinois 60606

(617) 345 - 9100

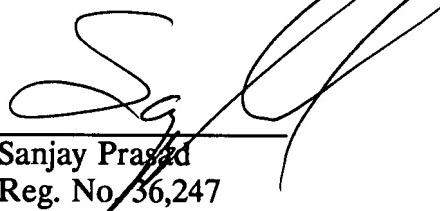


CERTIFICATE OF MAILING

I hereby certify that the foregoing Petition is being deposited with the United States Postal Service as first class mail, postage prepaid, on the 10th day of June, 1994 in an envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231.

6/10/94

Date of Signature



Sanjay Prasad
Reg. No. 36,247

Ser. No. 07/872,674



89,348-A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	
)	
Michael F. Jones)	Before the Examiner:
)	
Serial No.: 07/872,674)	B. Gregory
)	
Filed: April 23, 1992)	Group Art Unit:
)	
For: Encrypted Data Transmission System)	2202
Employing Means for Randomly)	
Altering the Encryption Keys)	

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231
BOX DAC

STATEMENT OF UNINTENTIONAL ABANDONMENT

I, Charles G. Call, residing at 4 Pheasant Run, Hingham, Massachusetts 02043, hereby declare:

1. I am an attorney admitted to practice in Massachusetts and am a member of the firm of Allegretti & Witcoff, Ltd. with offices at 75 State Street, Boston, Massachusetts.

2. I am registered to practice before the United States Patent and Trademark Office in Patent Cases. My registration number is 20,406.

3. I am an attorney of record in the present application and am primarily responsible for prosecution of the present application.

4. On or about July 12, 1993, I received an Office Action mailed from the U.S. Patent and Trademark Office (PTO) on July 8, 1993, a copy of which is attached as Exhibit A. In

the Office Action, which was a final action, the Examiner rejected claims 8, 11 and 12. In addition, the Examiner objected to claims 9 and 10 but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Objected claim 9 depended upon claim 8 and objected claim 10 depended upon claim 9.

5. On December 8, 1993, I caused to be mailed to the PTO, a response to the aforesaid Office Action along with a Petition for Extension of Time under 37 CFR 1.136(a). A copy of the response is attached as Exhibit B and a copy of the Petition for Extension of Time is attached as Exhibit C.

6. The aforesaid response requested that claims 8, 9, 11 and 12 be cancelled. In addition, the response requested the entry of a new independent claim 13. Claim 13 included the limitations of objected claim 9 along with the limitations of base claim 8. The response also requested that claim 10 be amended to depend upon new claim 13 rather than cancelled claim 9.

7. On or about February 3, 1994, I received an Advisory Action from the PTO mailed on January 28, 1993, a copy of which is attached as Exhibit D. The Advisory Action indicated that the proposed amendments would not be entered because (i) there was no convincing showing under 37 CFR 1.116(b) why the proposed amendment was necessary and was not earlier presented, (ii) that the proposed amendments raised new issues that would require further consideration and/or search, and (iii) they were not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

8. The aforesaid Advisory Action set a period for response which continued to run five months from the date of the Final Rejection which July 8, 1993.

9. On or about February 14, 1994, I received a Notice of Abandonment from the PTO, a copy of which is attached as Exhibit E.

10. The aforesaid response mailed on December 8, 1993 was, and is, believed to be fully responsive to the Office Action of July 8, 1993 and was believed to place claims 13 and 10 in condition for allowance. Accordingly, the aforesaid Advisory Action refusing entry of the amendments contained in the response of December 8, 1993, and setting a period for response which had already expired, was neither intended nor expected.

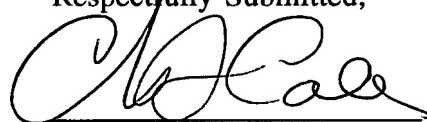
11. I hereby state pursuant to 37 CFR 1.137(b) that the abandonment of the present application was unintentional.

12. I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize validity of the application or any patent issuing thereon.

Date

June 10, 1994

Respectfully Submitted,



Charles G. Call
Attorney for Applicant
Reg. No. 20,406

CERTIFICATE OF MAILING

I hereby certify that the foregoing Statement of Unintentional Abandonment is being deposited with the United States Postal Service as first class mail, postage prepaid, on the 10th day of June, 1994 in an envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231.

6/10/94

Date of Signature


Sanjay Prasad
Reg. No. 36,247

Ser. No. 07/872,674



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

FIRST NAME OR NUMBER
ATTORNEY DOCUMENT NO.

07/872,674 04/23/92 JONES

M 89-348A

22M1/0708

GREGORY, R. MINER

ALLEGRETTI & WITCOFF, LTD.
TEN SOUTH WACKER DR.
CHICAGO, IL 60606

PAPER NUMBER

2202

DATE MAILED: 07/08/93

THE PUBLICATION OF THIS DOCUMENT IS NOT A COMMUNICATION WITH AN AGENT, ATTORNEY, OR OTHER PERSON IN THE TRADE AND MANUFACTURING

This application has been examined Responsive to communication filed on 3/30/93 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1448. 4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474. 6.

Part II SUMMARY OF ACTION

1. Claims 8-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. Claims 1-7 have been cancelled.
3. Claims _____ are allowed.
4. Claims 8,11,+12 are rejected.
5. Claims 9-10 are objected to.
6. Claims _____ are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).
11. The proposed drawing correction, filed on 12/14/92, has been approved. disapproved (see explanation).
12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other **THE 3/30/93 DRAWINGS HAVE BEEN RECEIVED, AND ARE UNDER REVIEW BY THE PTO DRAFTSMAN.**

EXAMINER'S ACTION

This Office Action is in response to Applicant's Amendment A of 04 December 1992 and to Applicant's Amendment B of 30 March 1993. It is noted that claims 1-7 have been cancelled, and that claims 8-12 are newly-added. Claims 8-12 are in the case.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

Claim 8 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Lee et al ('027); Weldon, Jr. ('246); or, Feistel ('055).

Lee et al ('027); Weldon, Jr. ('246); and, Feistel ('055) all show systems that use pseudorandom sequences to encrypt and decrypt the data sent between the two communicating parties. It is noted that the language in claim 8 does not link the provision of the "seed value" to the transmitter and the provision of the "seed value" to the receiver. Further, it is noted that "providing" does not indicate that the "seed value" is generated. Please note in section 4.1 of Primality and Cryptography by Evangelos Kranakis that the use of seed values is inherent in pseudorandom number generators.

Claim 12 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Lee et al ('027).

As for the further limitation of dependent claim 12, the provision of the "seed value" via mail (as written in Figure 1) is inherently the provision of the seed value from a center separate from the transmitter and the receiver in the the transmitter is not a mailing facility. Please note column 3, lines 32-49 of Lee et al ('027) with respect to seeding.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Claim 11 is rejected under 35 U.S.C. 103 as being unpatentable over Lee et al ('027); Weldon, Jr. ('246); or, Feistel ('055).

It would have been obvious to one of ordinary skill-in-the-art to compress the data communicated in Lee et al ('027); Weldon, Jr. ('246); or, Feistel ('055) for the old and well-known advantage of greater data capacity per unit of time.

Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Section 4.1 of "Primality and Cryptography" by Evangelos Kranakis is cited to show that the use of seed values is inherent in pseudorandom number generators.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE

ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Bernarr Gregory whose telephone number is (703)-308-0479. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-0766.

BERNARR E. GREGORY
PRIMARY EXAMINER
GROUP 2200



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(89,348-A)

In the Application of:

Michael F. Jones

Serial No.: 07/872,674

Filed: April 23, 1992

For: Encrypted Data Transmission System
Employing Means for Randomly
Altering the Encryption Keys

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Before the Examiner:

B. Gregory

Group Art Unit:

2202

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231
BOX AF

AMENDMENT AFTER FINAL

Sir:

In response to the Office Action mailed July 8, 1993, please amend the above identified application as follows:

IN THE CLAIMS:

Cancel claims 8, 9, 11 and 12.

Claim 10, line 1, change "claim 9" to --claim 13--.

Please add new claim 13:

- 1 13. A method for transmitting data comprising a sequence of blocks in encrypted form
- 2 over a communication link from a transmitter to a receiver comprising, in combination, the
- 3 steps of:

4 providing a seed value to both said transmitter and receiver,
5 generating a first sequence of pseudo-random key values based on said seed value at
6 said transmitter, each new key value in said sequence being produced at a time dependent
7 upon a predetermined characteristic of the data being transmitted over said link,
8 encrypting the data sent over said link at said transmitter in accordance with said first
9 sequence,
10 generating a second sequence of pseudo-random key values based on said seed value
11 at said receiver, each new key value in said sequence being produced at a time dependent
12 upon said predetermined characteristic of said data transmitted over said link such that said
13 first and second sequences are identical to one another, a new one of said key values in said
14 first and said second sequences being produced each time a predetermined number of said
15 blocks are transmitted over said link, and
16 decrypting the data sent over said link at said receiver in accordance with said second -
17 sequence.

REMARKS

Claims 8-12 are pending in the application. Claims 8, 11 and 12 stand rejected.
Claims 9 and 10 stand objected to by the Examiner as being dependent upon a rejected base
claim, but would be allowable if rewritten in independent form including all of the elements
of the base claim and any intervening claims. Applicant notes that the drawings submitted on
March 30, 1993 are under review.

The above amendments cancel claims 8, 9, 11 and 12, amend claim 10 and add a new

claim 13. In response to the Examiner's objection to claims 9 and 10, claim 10 has been amended and new claim 13 has been added. New claim 13 incorporates the elements of claims 8 and 9. Claim 10 now depends upon claim 13 and accordingly incorporates all of the elements of the independent claim (claim 8) and any intervening claims (claim 9).

Accordingly, allowance of claims 13 and 10 is respectfully requested.

Respectfully submitted,

By: 

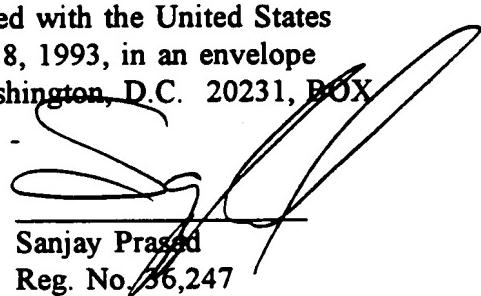
Charles G. Call
Reg. No. 20,406

Dated: Dec 8, 1993

CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

I hereby certify that the foregoing paper is being deposited with the United States Postal Service as first class mail, postage prepaid, on December 8, 1993, in an envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231, BOX AF.

12/8/93
Date of Signature


Sanjay Prasad
Reg. No. 36,247



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(89,348-A)

In the Application of:)
Michael F. Jones) Before the Examiner:
Serial No.: 07/872,674) B. Gregory
Filed: April 23, 1992) Group Art Unit:
For: Encrypted Data Transmission System) 2202
Employing Means for Randomly)
Altering the Encryption Keys)

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231
BOX AF

PETITION FOR EXTENSION OF TIME

Sir:

Applicant requests a two month extension of time pursuant to 37 CFR 1.136(a) in which to respond to the Office Action dated July 8, 1993. A response was due October 8, 1993, and a two month extension extends the period for response to December 8, 1993. Please charge the required fee of \$180.00, as set forth in 37 CFR 1.17(b) for a small entity, to Deposit Account No. 01-0850. Please charge any additional fees or credit any overpayment to Deposit Account No. 01-0850.

Respectfully submitted,

Dated: Dec. 8, 1993

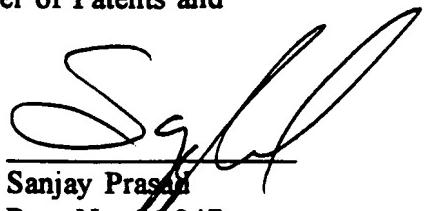
By: 

Charles G. Call
Reg. No. 20,406

CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

I hereby certify that the attached PETITION FOR EXTENSION OF TIME is being deposited with the United States Postal Service as first class mail, postage prepaid, on December 8, 1993, in an envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231, BOX AF.

12/8/93
Date of Signature


Sanjay Prasad
Reg. No. 56,247

43
JUN
15
1994



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/870,671	04/20/92	JONES	M 1812-2402A
		22M2/9128	
			EXAMINER
			ART UNIT PAPER NUMBER
			2202
			DATE MAILED:

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE PERIOD FOR RESPONSE:

- is extended to run _____ from the date of the Final Rejection
 - continues to run 5 Mo. from the date of the Final Rejection
 - expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.
- Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.
- Appellant's Brief is due in accordance with 37 CFR 1.162(a).
 - Applicant's response to the final rejection, filed 12/13/93, has been considered with the following effect, but it is not deemed to place the application in condition for allowance:
1. The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
 - a. There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. They raise new issues that would require further consideration and/or search. (See Note).
 - c. They raise the issue of new matter. (See Note).
 - d. They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: PROPOSED CLAIM 13 APPEARS NOT TO BE
PATENTABLE OVER PRIOR ART OF
RECORD.

2. Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
 3. Upon the filing of an appeal, the proposed amendment will be will not be admitted and the status of the claims in this application would be as follows:
Allowed claims: HEB 03 804
Claims objected to: _____
Claims rejected: _____
- However:
- a. The rejection of claims _____ on references is deemed to be overcome by applicant's response.
 - b. The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.
4. The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.
 5. The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.
 - The proposed drawing correction has has not been approved by the examiner.
 - Other

Bernarr E. Gregory

BERNARR E. GREGORY
PRIMARY EXAMINER
GROUP 2200